UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/483,063	01/14/2000	Ker Sze Toh	1662-15100(P99-2434)	7851

22879 7590 07/23/2004	EXAMINER
HEWLETT PACKARD COMPANY	DINH, MINH

HEWLETT PACKARD COMPANY
P O BOX 272400, 3404 E. HARMONY ROAD
INTELLECTUAL PROPERTY ADMINISTRATION
FORT COLLINS, CO   80527-2400

ART UNIT	PAPER NUMBER
2132	

DATE MAILED: 07/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/483,063	TOH ET AL.
	Examiner	Art Unit
	Minh Dinh	2132

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 May 2004*.

2a)☒ This action is **FINAL.**   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-25* is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-25* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *14 January 2000* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☒ All   b)☐ Some * c)☐ None of:

   1.☒ Certified copies of the priority documents have been received.

   2.☐ Certified copies of the priority documents have been received in Application No. _____.

   3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
   Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____ .

DETAILED ACTION

Response to Amendment

1.　This action is in response to the amendment filed 3/18/2004 that amended claims

1, 8, 15, 20 and 24-25.

Response to Arguments

2.　Applicant's arguments with respect to claims 1, 8, 15, 20 and 24 have been

considered but are moot in view of the new ground(s) of rejection.

Claim Objections

3.　Claim 15 is objected to because of the following informalities: "at least one

custom-ordered software products" (6th line), software products should be in singular

form. Appropriate correction is required.

Claim Rejections - 35 USC § 112

4.　The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

5.　Claim 24 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite

for failing to particularly point out and distinctly claim the subject matter which applicant

regards as the invention. Claim 24 recites "comparing identifiers stored in a memory

with identifiers of a plurality of software products". It is not clear whether one group of

identifiers is compared to the other group of identifiers or each identifier of one group is

compared to each identifier of the other group. For examination purposes, the limitation

is interpreted as "comparing the identifier of each software product of a plurality of

software products with each of identifiers stored in a memory".

Claim Rejections - 35 USC § 102

6.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7.   Claims 24-25 are rejected under 35 U.S.C. 102(e) as being anticipated by

Yoshida et al. (6,075,862).

a.   Regarding claim 24, Yoshida discloses a method comprising:

comparing the identifier of each software product of a plurality of software

products with each of identifiers stored in a memory (col. 6, lines 3-11, 27-40; fig. 6,

elements 100 and fig. 7, element 61);

re-installing each software product in a computer system only if its identifier

matches one identifier stored in the memory, re-installing a software product meets the

limitation of installing a software product (col. 6, lines 3-11, 27-40);

after said re-installing each software product, adding one or more identifiers into the memory to install new software products (col. 7, lines 17-20; fig. 9).

b.   Regarding claim 24, Yoshida discloses a serial number of the computer system being provided to a software distribution center and used to encrypt the entitlement information for a new software product (col. 7, lines 21-28). Yoshida also discloses that the entitlement information is decrypted at the customer's computer system using the system's serial number (col. 7, lines 42-50). Since the entitlement information, which is required to add the identifier of the new software product into the memory (fig. 9), can only be decrypted if the serial numbers match, Yoshida's teaching meets the limitation of the claim.

Claim Rejections - 35 USC § 103

8.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9.   Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshida in view of Santon et al. (5,058,162) and Mullor et al. (6,411,941).

a. Regarding claim 1, Yoshida discloses a software delivery system comprising:

a digital storage device containing a software product, said software product having been assigned a unique identifier (fig. 1, item 10); and

a computer system, said computer system having a drive for reading data stored on the digital storage device, a processor, a memory unit (fig. 1), said computer system having pre-stored before installation of the software product at least one identifier corresponding to the identifier of said software product in the memory unit (fig. 1, item 13; fig. 9, steps S12-S13);

whereby when said digital storage device is read by said drive, the software product having an identifier which corresponds to the at least one identifier stored in the hard drive is loaded onto said computer system (fig.6 and col. 6, lines 3-11, 27-40; fig. 9, steps S14-15).

Yoshida does not disclose that the digital storage device contains a plurality of software products. Santon discloses distributing a digital storage device containing a plurality of software products, not all of which a recipient is entitled to (fig. 2; col. 2, lines 52-64). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Yoshida system such that the digital storage device contains a plurality of software products, not all of which a recipient is entitled to, as taught by Stanton; accordingly, the Yoshida computer system would only have the identifiers corresponding to the software products that the recipient is entitled to. The motivation for dong so would have been to achieve significant cost savings through large volume distribution of software (col. 1, lines 30-35).

Yoshida does not disclose using a non-volatile memory to store the identifiers. Mullor discloses using a non-volatile memory to store data regarding software usage authorization (col. 1, lines 48-67). It would have been obvious to one of ordinary skill in

the art at the time the invention was made to modify the Yoshida system to use a non-volatile memory to store the identifiers, which are software usage authorization data, as taught by Mullor. It would be more difficult to tamper with data stored in a non-volatile memory (col. 3, lines 4-9).

b. Regarding claim 2, Yoshida does not disclose that the non-volatile memory may be updated to include additional identifiers. Mullor further discloses that the non-volatile memory can be updated to include additional records (col. 2, lines 1-5). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Yoshida system such that the non-volatile memory may be updated to include additional identifiers, as taught by Mullor. The motivation for doing so would have been that additional software could be used with the computer system.

c. Regarding claim 3, Yoshida does not disclose that the non-volatile memory is read-only memory. Mullor further discloses that the non-volatile memory is read-only memory (col. 1, lines 46-48). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Yoshida system such that the non-volatile memory is read-only memory, as taught by Mullor. The motivation for doing so would have been that data couldn't be removed or modified.

d. Regarding claim 4, Yoshida does not disclose that the identifier in the non-volatile memory is encrypted. Mullor further discloses that the content of the non-volatile memory is encrypted, resulting in a stricter verification method (col. 5, lines 25-27; col. 6, lines 28-39). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Yoshida system such that the identifiers in the

non-volatile memory is encrypted, as suggested by Mullor, in order to achieve a stricter

verification method.

e. Regarding claim 5, Yoshida does not disclose that the computer system comprises

an update module for updating the non-volatile memory to include additional identifiers.

Mullor further discloses an update module for updating the non-volatile memory to

include more program names, which meets the limitation of software product identifiers

(col. 1, lines 53-58; col. 2, lines 1-5). It would have been obvious to one of ordinary skill

in the art at the time the invention was made to modify the Yoshida system such that it

comprises an update module for updating the non-volatile memory to include additional

identifiers, as suggested by Mullor. The motivation for doing so would have been that

additional software could be used with the computer system.

f. Regarding claim 6, Yoshida further discloses that the software delivery system

comprises a serial number stored in the computer system (fig. 4, item 22).

g. Regarding claim 7, Yoshida does not disclose that the serial number is stored in the

non-volatile memory. Mullor further discloses that the serial number is stored in a ROM

section (col. 1, lines 46-52). It would have been obvious to one of ordinary skill in the

art at the time the invention was made to modify the Yoshida system such that the serial

number is stored in a ROM section, as suggested by Mullor. The motivation for doing

so would have been that the serial number could not be removed or modified.

h. Regarding claim 8, it differs from claim 1 in that the digital storage device contains a

plurality of software modules containing at least one software product and that each of

the software modules has been assigned a unique identifier. Stanton disclose a digital

storage device containing a plurality of software modules containing at least one

software product and that each of the software modules has been assigned a unique

identifier (col. 3, lines 46-51). It would have been obvious to one of ordinary skill in the

art at the time the invention was made to modify the Yoshida such that the digital

storage device contains a plurality of software modules containing at least one software

product and that each of the software modules has been assigned a unique identifier,

as suggested by Stanton. The motivation for doing so would have been that significant

cost savings could be achieved (col. 1, lines 30-35) and that related software products

could be accessed together as a software module (col. 3, lines 46-51; col. 5, lines 14-

22).

i.   Regarding claim 9, Yoshida does not disclose that the non-volatile memory may be

updated to include additional identifiers. Mullor further discloses that the non-volatile

memory can be updated to include additional records (col. 2, lines 1-5). It would have

been obvious to one of ordinary skill in the art at the time the invention was made to

modify the Yoshida system such that the non-volatile memory may be updated to

include additional identifiers, as taught by Mullor. The motivation for doing so would

have been that additional software could be used with the computer system.

j.   Regarding claim 10, Yoshida does not disclose that the non-volatile memory is read-

only memory. Mullor further discloses that the non-volatile memory is read-only

memory (col. 1, lines 46-48). It would have been obvious to one of ordinary skill in the

art at the time the invention was made to modify the Yoshida system such that the non-

volatile memory is read-only memory, as taught by Mullor. The motivation for doing so would have been that data couldn't be removed or modified.

k. Regarding claim 11, Yoshida does not disclose that the identifier in the non-volatile memory is encrypted. Mullor further discloses that the content of the non-volatile memory is encrypted, resulting in a stricter verification method (col. 5, lines 25-27; col. 6, lines 28-39). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Yoshida system such that the identifiers in the non-volatile memory is encrypted, as suggested by Mullor, in order to achieve a stricter verification method.

l. Regarding claim 12, Yoshida does not disclose that the computer system comprises an update module for updating the non-volatile memory to include additional identifiers. Mullor further discloses an update module for updating the non-volatile memory to include more program names, which meets the limitation of software product identifiers (col. 1, lines 53-58; col. 2, lines 1-5). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Yoshida system such that it comprises an update module for updating the non-volatile memory to include additional identifiers, as suggested by Mullor. The motivation for doing so would have been that additional software could be used with the computer system.

m. Regarding claim 13, Yoshida further discloses that the software delivery system comprises a serial number stored in the computer system (fig. 4, item 22).

n. Regarding claim 14, Yoshida does not disclose that the serial number is stored in the non-volatile memory. Mullor further discloses that the serial number is stored in a

ROM section (col. 1, lines 46-52). It would have been obvious to one of ordinary skill in

the art at the time the invention was made to modify the Yoshida system such that the

serial number is stored in a ROM section, as suggested by Mullor. The motivation for

doing so would have been that the serial number could not be removed or modified.

10.   Claims 15-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over

O'Connor (5,894,571) in view of Day et al (6,016,400) and Mullor et al. (6,411,941).

a. Regarding claim 15, which is representative of claims 20-21, O'Connor discloses a

process for delivery of custom-ordered software products to a computer system having

anticipated elements. The process comprises the steps of:

   writing custom-ordered software products onto a digital storage device (col. 4,

lines 46-49, col. 5, lines 21-25);

   assigning a unique identifier to the digital storage device (col. 6, lines 17-18);

   writing the identifier to an internal storage of the computer system (col. 6, lines

14-15, 37-40);

   inserting the digital storage device into the computer system (col. 6, lines 29-31);

   reading the identifier stored in the computer system (col. 6, lines 37-39);

   comparing the retrieved identifier with one assigned to the digital storage device

that contains the custom-ordered software products (col. 6, lines 39-40);

   installing the custom-ordered software products if the identifiers match (col. 6,

lines 40-41);

The O'Connor reference differs from the claimed invention in that the digital

storage device contains only the custom-ordered software products, and one identifier is

stored and used for installation verification of all custom-ordered software products

stored on the digital storage device. Day discloses a process for delivery of custom-

ordered software products to a computer system, which utilizes a digital storage device

containing not only the custom-ordered software products for a computer system but

also other software products that can be installed on that particular computer system

(col. 3, lines 32-36). Day does not explicitly disclose that each software product in the

storage device is assigned a unique identifier which is used for installation verification

purpose, however, this feature is deemed to be inherent to the Day process because it

is able to identify the custom-ordered software products among other software products

stored in the storage device and install them onto the computer system (fig. 3, step

116). It would have been obvious to one of ordinary skill in the art at the time the

invention was made to modify the process of O'Connor such that the digital storage

device containing not only the custom-ordered software products for a computer system

but also other software products that can be installed on that particular computer

system; and that a unique identifier used for installation verification purpose is assigned

to each software product in the storage device, as taught by Day. Accordingly the

software product identifiers of the custom-ordered software product would be stored and

used for installation verification in place of the identifier assigned to the digital storage

device. The motivation for doing so would have been that single manufacturing CD

ROM (and copies thereof) is employed for preloading each computer system

irrespective of the required software configuration for the particular computer system
(col. 3, lines 36-39).

O'Connor does not disclose using a non-volatile memory to store the identifiers.
Mullor discloses using a non-volatile memory to store data regarding software usage
authorization (col. 1, lines 48-67). It would have been obvious to one of ordinary skill in
the art at the time the invention was made to modify the Yoshida system to use a non-
volatile memory to store the identifiers, which are software usage authorization data, as
taught by Mullor. It would be more difficult to tamper with data stored in a non-volatile
memory (col. 3, lines 4-9).

b. Regarding claim 16, O'Connor fails to teach that the set of software products is
written onto the digital storage device before the custom-ordered software products is
ordered. However, Day discloses that a set of software products is written onto the
digital storage device before the custom-ordered software products is ordered (col. 2,
lines 30-32; col. 3, lines 32-36). It would have been obvious to one of ordinary skill in
the art at the time the invention was made to modify the process of O'Connor such that
the set of software products is written onto the digital storage device before the custom-
ordered software products is ordered, as taught by Day, to take advantage of the CD
ROM already present in the system.

c. Regarding claim 17, O'Connor further discloses that the software products are
tested before they are written onto the digital storage device (col. 4, lines 50-55).

d. Regarding claim 18, O'Connor does not disclose that the identifier in the non-volatile
memory is encrypted. Mullor discloses that the content of the non-volatile memory is

encrypted, resulting in a stricter verification method (col. 5, lines 25-27; col. 6, lines 28-

39). It would have been obvious to one of ordinary skill in the art at the time the

invention was made to modify the Yoshida system such that the identifiers in the non-

volatile memory is encrypted, as suggested by Mullor, in order to achieve a stricter

verification method.

e. Regarding claim 19, O'Connor further discloses the step of checking the serial

number of the computer system before installing the custom-ordered software products

to the computer system (col. 6, lines 9-12, 37-41), which meets the limitation of

checking the serial number of the computer system before writing the identifiers of the

custom-ordered software product into the non-volatile memory of the computer system.

11.   Claims 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over

O'Connor, Day and Mullor as applied to claim 20 above, and further in view of Yoshida.

O'Connor, Day and Mullor does not disclose that the processor is adapted to execute a

program that causes the processor to store additional software identifiers in the

system's storage that were previously not stored in the system's storage and each of

the additional software identifiers allows installation of one previously unavailable

software product stored on the removable storage device. Yoshida discloses a

processor adapted to execute a program that causes the processor to store additional

software identifiers in the system's storage that were previously not stored in the

system's storage (fig. 9, step S13). Yoshida further discloses that each of the additional

software identifier allows installation of one previously unavailable software product

stored on the removable storage device (fig. 9, step S15). It would have been obvious

to one of ordinary skill in the art at the time the invention was made to modify the

combined system of O'Connor, Day and Mullor system such that additional software

identifiers are stored in the system's storage and each of the additional software

identifiers allows installation of a previously unavailable software product stored on the

removable storage device, as taught by Yoshida, so that new software products can be

installed on the computer system.

Conclusion

12.   Applicant's amendment necessitated the new ground(s) of rejection presented in

this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37

CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Minh Dinh whose telephone number is 703-306-5617. The examiner can normally be reached on Mon - Fri: 9:00 am - 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on 703-305-1830. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MD

Minh Dinh
Examiner
Art Unit 2132

MD
07/16/2004

JUSTIN T. DARROW
PRIMARY EXAMINER